

REMARKS

By this Amendment, Applicants amend claims 1 and 10 and cancel claims 3, 8, 9, and 11 without any prejudice or disclaimer of the subject matter thereof. Applicants also add new claims 13 and 14 to address other aspects of the present invention. Upon entry of this Amendment, claims 1, 2, 4-7, 10, and 12-14 will be pending.

In the Office Action, the Examiner rejected claims 1-12 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. 2002/0021746 to Schmidl et al. ("Schmidl").¹ Applicants respectfully traverse the Examiner's rejection.

Regarding Applicants' IDS Filed Concurrently with the Application

Applicants note that the Examiner did not return Form PTO 1449 of the Information Disclosure Statement (IDS) filed with this Application on December 26, 2001. Applicants therefore respectfully request the Examiner to return initialized 1449 Form filed on December 26, 2001, in the next Office Action.

Regarding Claim Rejection under 35 U.S.C. § 102

Applicants respectfully traverse the Examiner's rejection of claims 1-12 under 35 U.S.C. § 102(e) as anticipated by Schmidl. In order to anticipate Applicants' claimed invention under 35 U.S.C. § 102, each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Independent claim 1, as amended, recites a combination including, for example, “determining again whether the carrier of said another wireless communication system is present in the frequency channel excluded from the frequency channels targeted for the frequency hopping; and adding the excluded frequency channel to the frequency channels targeted for the frequency hopping when the carrier of said another wireless communication system is not detected.” Schmidl fails to disclose at least the above elements as recited in amended claim 1.

Schmidl teaches “[a] frequency hopping system such as a Bluetooth system (300) [that] can reduce the number of RF channels it hops during a normal hopping sequence cycle providing for a Reduced Hopping Sequence (RHS).” Schmidl, abstract. In Schmidl, “[o]nce the master radio determines the RF channel(s) to avoid, the master can communicate this information to enhanced slave units that are capable of supporting the reduced hopping sequences (RHS) of the present invention. The master device radio can then communicate with the enhanced slaves using RHS, but will continue to communicate with normal Bluetooth slaves using the normal Bluetooth hopping sequence (i.e., using all of the 79 RF channels). The enhanced slave units are those slave units that are programmed in accordance with the present invention to accept a reduction in the number of RF channels used in their hopping sequences.” Schmidl, para. [0012]. However, Schmidl’s teaching of a reduced hopping sequence for enhanced slave units does not constitute “determining again whether the carrier of said another wireless communication system is present in the frequency channel excluded from the frequency channels targeted for the frequency hopping; and adding the excluded frequency channel to the frequency channels targeted for the frequency

hopping when the carrier of said another wireless communication system is not detected,” as recited in amended claim 1 (emphasis added).

The Examiner alleged that “Schmidl et al inherently teaches determining again whether the carrier of said another wireless communication system is present in the frequency channel excluded from the frequency channels targeted for the frequency hopping; and adding the excluded frequency channel to the frequency channels targeted for the frequency hopping when the carrier of said another wireless communication system is not detected.” (Office Action at 3.) Applicants respectfully disagree.

“To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).” M.P.E.P. § 2112.

As explained above, Schmidl teaches that the master radio will “communicate with the enhanced slaves using RHS, but will continue to communicate with normal Bluetooth slaves using the normal Bluetooth hopping sequence.” Schmidl, para. [0012], emphasis added. Because the normal Bluetooth hopping sequence is used concurrently, it is not necessary for Schmidl to include “determining again whether the carrier of said another wireless communication system is present in the frequency channel excluded from the frequency channels targeted for the frequency hopping; and adding the excluded frequency channel to the frequency channels targeted for the

frequency hopping when the carrier of said another wireless communication system is not detected,” as recited in amended claim 1 (emphasis added).

Therefore, Schmidl fails to disclose each and every element of Applicants’ invention recited in amended claim 1, either explicitly or inherently. Schmidl thus cannot anticipate claim 1 under 35 U.S.C. § 102(e). Accordingly, Applicants respectfully request withdrawal of the Section 102 rejection of claim 1. Because claims 2 and 4-7 depend from claim 1, either directly or indirectly, Applicants also request withdrawal the Section 102 rejection of claims 2 and 4-7 for at least the same reasons as stated above.

Independent claim 10, while of different scope, recites similar language to that of claim 1. Claim 10 is therefore also allowable for at least the same reasons as stated above. Applicants respectfully request withdrawal of the Section 102 rejection of claim 10 and claim 12, which depends from claim 10.

Because claims 3, 8, 9, and 11 have been canceled, the rejection of claims 3, 8, 9, and 11 is moot.

Regarding Newly Added Claims

Applicants have added new claims 13 and 14 to address other aspects of the present invention. Support for claims 13 and 14 may be found at, for example, pages 12-14 of the specification. Because claims 13 and 14 depend from claim 1 and 10, respectively, claims 13 and 14 are allowable for at least as being dependent on an allowable base claim.

Conclusion


In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 
Wenye Tan
Reg. No. 55,662